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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,617	10/25/2001	Shell S. Simpson	10007679-1	3072

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

RAHIMI, IRAJ A

ART UNIT PAPER NUMBER

2622

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/052,617

Applicant(s)

SIMPSON, SHELL S.

Examiner

(Iraj) Alan Rahimi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 21-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

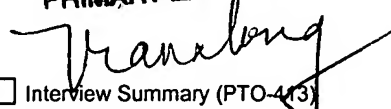
- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

DOUGLAS Q. TRAN
PRIMARY EXAMINER

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. In papers filed on December 1, 2005 applicant amended claims 1-6, 8-9, 11-12 and 18. Applicant canceled claim 20 and added new claims 26-32.

Response to Arguments

2. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection. Since the previous office action by the first examiner did not address all the claims, this action is Non-Final.

Specification

3. The disclosure is objected to because of the following informalities: Specification on page 4 is missing the serial number for the US patent application that is being incorporated by reference.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-19, 21-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not

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described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant disclosure on page 6, lines 17-20 state that the hard copy generation system comprises a folding and sealing machine. On page 8, lines 10-14 applicant discloses that notification information identifies that one or more print-to-mail document has been printed. Nowhere could examiner find any reference for generating notification information that identifies that the print-to-mail format document has been folded and sealed as a mailing also, as recited in independent claims. A system that has folding and sealing capability does not automatically causes a notification be issued when such operations have been performed. Applicant representative, Mr. David Risley was contacted by phone twice prior to this action to help clarify the 112 issue but he could not be reached.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-7, 12-15, 18, 21, 26-29 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tammi (US patent (5,726,897) in view of Gleason (US patent 5,091,777).

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8. Regarding claim 1, Tammi discloses a method for print-to-mail notification, comprising:
determining that a print-to-mail format document has been printed, folded, and sealed as a mailing (column 4, lines 27-42);

generating notification information that identifies that the print-to-mail format document has been printed folded and sealed as a mailing (column 4, lines 27-42). Post processing includes folding and sealing as discloses in column 7, lines 15-27. Tammi discloses in column 4, lines 40-42 that post processing means can also verify receipt and matching of printed statement.

Verifying receipt of document is considered equivalent to generating notification information.

However, Tammi does not disclose the step of identifying attributes of the print-to-mail format document.

Gleason discloses the above limitation in column 5, lines 27-30.

Tammi and Gleason are combinable because they are from the same field of endeavor that is document assembly for mailing.

At the time of the invention, it would have been obvious to a person ordinary skill in the art to identify the attributes of the print-to-mail document.

The suggestion/motivation for doing so would have been to correlate a mailing with a specific recipient.

Therefore, it would have been obvious to combine Tammi and Gleason to obtain the invention as specified in claim 1.

Regarding claim 2, Tammi discloses the method of claim 1, wherein determining that a print-to-mail format document has been printed folded, and sealed as a mailing comprises detecting printing, folding and sealing of the print-to-mail document (column 4, lines 40-42).

Regarding claim 3, Tammi discloses the method of claim 1, wherein determining that a print-to-mail format document has been printed folded, and sealed as a mailing comprises receiving a notice from a print-to-mail device component that a print-to-mail format document has been printed folded and sealed (column 4, lines 40-42).

Regarding claim 4, Gleason discloses 4 the method identifying document of claim 1 wherein attributes comprises identifying at least one of a name of the document, a date the document was printed, and a name of a user (column 5, lines 28-30).

Regarding claim 5, Gleason discloses the method of claim 1, wherein identifying document attributes comprises identifying at least one of a customer name, a customer number, a billing period to which the document pertains (column 5, lines 28-30).

Regarding claim 6, Gleason discloses the method of claim 1, wherein identifying document attributes comprises identifying at least one of a customer name, a customer number, a billing period to which the document pertains (column 5, lines 21-30).

Regarding claim 7, Tammi discloses the method of claim 1, wherein generating notification information comprises generating notification information that identifies at least one of the document attributes (column 4, lines 52-60).

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Regarding claim 26, Gleason discloses the device of claim 21, wherein the at least one attribute comprises at least one of a name of the document, a date the document was printed, and a name of a user (column 5, lines 28-30).

Regarding claim 29, Tammi discloses the device of claim 28, wherein the recipients are customers of a business and the mailings comprise bills that are to be mailed to the customers (column 1, lines 20-38).

9. Claims 8-10, 16, 19, 2-25 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tammi (US patent (5,726,897) in view of Gleason (US patent 5,091,777) and further in view of Stewart (US patent 6,714,964).

Regarding claim 8, Tammi does not disclose the method of claim 7, wherein transmitting notification information comprises transmitting notification information to a remote computing device via a network.

However, Stewart discloses this limitation in abstract.

Tammi, Gleason and Stewart are combinable because they are from the same field of endeavor that is printing services.

At the time of the invention, it would have been obvious to a person ordinary skill in the art to store notification information in a remote computing device (web server).

The suggestion/motivation for doing so would have been to enable a user to view images remotely.

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Therefore, it would have been obvious to combine Tammi, Gleason and Stewart to obtain the invention as specified in claim 8.

Regarding claim 9, Stewart discloses the method of claim 7, wherein transmitting notification information comprises transmitting the information to a database from which data contained within the print-to-mail format document originated (abstract).

Regarding claim 10, Tammi does not disclose the method of claim 9, wherein the database is supported by a network-based database management system. It is well known that data bases in a network are supported by network-based database management system.

Regarding claim 19, Tammi discloses the device of claim 18, wherein the hard copy generation hardware comprises a print engine (printer 30).

Regarding claim 24, Stewart discloses the device of claim 18, further comprising an embedded web server that supports a print-to-mail service that is accessible over a network (column 2, line 33).

Regarding claim 25, Stewart discloses the device of claim 24, wherein the service comprises a print-to-mail web service that is accessible over the Internet (column 2, line 33).

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10. Claims 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tammi (US patent (5,726,897) in view of Gleason (US patent 5,091,777) and further in view of Pollard (US patent 5,745,590).

Regarding claim 11, Tammi in view of Gleason do not disclose the method of claim 1, further comprising storing the notification information within memory of a print-to-mail device that printed, folded, and sealed the print-to-mail format document.

However, Pollard discloses in column 5, lines 29-37 memory 34 for storing information regarding diverted mail pieces.

Tammi, Gleason and Pollard are combinable because they are from the same field of endeavor that is document assembly for mailing.

At the time of the invention, it would have been obvious to a person ordinary skill in the art to store notification information within the memory.

The suggestion/motivation for doing so would have been to establish a reprint file.

Therefore, it would have been obvious to combine Tammi, Gleason and Pollard to obtain the invention as specified in claim 11.

Regarding claim 12, arguments analogous to those presented for claim 1, are presented.

Regarding claim 13, 21 arguments analogous to those presented for claim 4, are presented.

Regarding claim 14, 27 arguments analogous to those presented for claim 5, are presented.

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Regarding claim 15, arguments analogous to those presented for claim 7, are presented.

Regarding claim 16, 23, 31 arguments analogous to those presented for claim 8, are presented.

Regarding claim 17, arguments analogous to those presented for claim 11, are presented.

Regarding claim 18, 28, 32 arguments analogous to those presented for claim 1 and 11, are presented.

Regarding claim 22, 30 arguments analogous to those presented for claim 9, are presented.

Other Prior Art Cited

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bodie (US patent 6,823,237) discloses regeneration of misprocessed mail pieces.

Greive (US patent 6,027,270) discloses sheet-fed printing press with post-processing unit.

Contact Information

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Iraq) Alan Rahimi whose telephone number is 571-272-7411.

The examiner can normally be reached on Mon.-Fri. 8:00 - 4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.



Alan Rahimi
February 13, 2006

DOUGLAS Q. TRAN
PRIMARY EXAMINER

